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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,427	11/12/2003	James R. January	14045.015US	7160

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EXAMINER

GOFMAN, ANNA

ART UNIT PAPER NUMBER

1771

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,427	<b>Applicant(s)</b> JANUARY, JAMES R.	
	<b>Examiner</b> Anna Gofman	<b>Art Unit</b> 1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicant's response filed October 03, 2005. The rejection of claims 1-23 has been maintained. The 112, 2<sup>nd</sup> paragraph rejection and the rejection of claims 3 and 4 have been overcome by the present amendment. In addition, the rejection in view of Iguchi and Kronzer has been overcome. However, after an updated search, additional prior art has been found which renders the invention as currently claimed unpatentable for reasons herein below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 11/12/03 has been considered by the examiner, however the last cited reference is incomplete.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 8, 9, 11, 18, 19, and 21 recite the limitation "pigment and filler". There is insufficient antecedent basis for this limitation in the claim. Applicant claims a "pigment dispersant" and a "filler", but not a "pigment and filler".
6. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "pigment and filler", recited in claims 8, 9, 11, 18, 19, and 21 is

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indefinite. It is unclear what structure these combined materials represent. Examiner will interpret that the calcium carbonate, recited in claims 11 and 21, is a pigment in the paint mixture.

Further, the currently amended claims 13, 18, and 23 recite the new limitation, "the water soluble polymer is added to the paint mixture at a ratio of 1 to 30 weight percent based on the weight of solids in the paint mixture." It is unclear what Applicant implies by this limitation.

Claims 1, 9, 14, and 19 recite the limitation, "a coated substrate suitable for accepting water-based paints, pencils, and inks, comprising a substrate and a coating on the substrate, wherein the coating is formulated to accept water-based paints, pencils, and inks without unacceptable running or bleeding of the water-based paints, pencils, and inks in and on the coating." There is no indication of the present invention comprising a certain additive which would allow the removal of water-based paints, etc., without harming said coating.

7. Claims 1 and 14 provide for the use of "a substrate suitable for accepting water-based paints, pencils, and inks", and "a coating formulated to accept water-based paints, pencils, and inks without unacceptable running or bleeding of the water-based paints, pencils, and inks in and on the coating."

Claims 9 and 19 provide for the use of "a coated substrate for use by artists suitable for accepting water-based paints, pencils, and inks", and "a coating formulated to accept water-based paints, pencils, and inks without unacceptable running or

bleeding of the water-based paints, pencils, and inks in and on the coating and to allow the removal of the water-based paints, pencils, and inks...”

Since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1, 9, 14, and 19 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-12, 14-17, and 19-22 are rejected under 35 U.S.C. 102(b) as anticipated by Lovell (US 5,629,073).

Lovell teaches a coated substrate comprising a coating composition and a substrate (pg.1 col.2 lines 6-7). The coated substrate can have a flexible material of cotton. Cotton is inherently a closely woven canvas material. The coating composition is

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about 20-30 and even up to 80 weight percent latex, about 5 to about 50 weight percent dry ingredients, and about 20-30 and as little as 5 to as much as 70 weight percent water (pg.4 col.7 lines 1-7). The coating is a latex and water paint mixture (pg.3 col.5 lines 13-14) comprising surfactants in about 0.1% by weight (pg. 4 col.7 line 34), fillers and extenders (pg.3 col.5 lines 19), defoaming agents in small amounts of up to 0.5% (pg.3 col.6 line 54), dispersing agents (pg.3 col.5 line 54), and pigments such as calcium carbonate and talc (pg.3 col.6 lines 18-21). The extenders can be talc, in about 1 percent by weight (pg.3 col.6 lines 19-20). The aqueous latex paint dispersion, which is hydrophilic, may comprise polyvinyl alcohol or polyvinylpyrrolidone (pg.3 col.5 lines 33-59). From Applicant's specified amounts, the following percentages were calculated: 100-200 parts by weight latex, 57-48.5% by weight; 0-5 parts pigment dispersant, 0-1.2%; 0-2 parts defoamer, 0-0.49%; 75-100 parts pigment and filler, 43-24.3%; 0-50 parts extender, 0-12.1%; 0-5 parts surfactant, 0-1.2%, 0-50 parts water, 0-12.1%. Thus, claims 1-12, 14-17, and 19-22 are anticipated.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 13, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lovell.

The features of Lovell have been set forth above. Lovell is silent about the specific amount of pigment dispersant, the amount of calcium carbonate included in the paint mixture, and the amount of the water soluble polymer, which is mixed with the paint mixture. Lovell also fails to teach that the coating comprises a defoamer of 0.3 percent by weight, a surfactant of 0.63 percent by weight, and talc (as the extender) of 6.3 percent by weight of the total paint composition. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the desired percentages through the process of routine experimentation in order to arrive at values which offered the optimum composition in the invention of Lovell. Thus, claims 13, 18, and 23 are rejected.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition to the references provided by Applicant, the following documents are considered pertinent to Applicant's invention:

Ahluwalia (US 2003/0176125) teach a coated substrate comprising all of the materials of Applicant's invention, but does not disclose the exact amounts of each.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Gofman whose telephone number is (571) 272-7419. The examiner can normally be reached on Mon.-Fri. 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anna Gofman  
Examiner  
Art Unit 1771

AG

*Ula Ruddock*  
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**PRIMARY EXAMINER**